

### REMARKS

Claims 1 – 20 remain in the application and stand rejected. Claims 1, 5, 6, 9, 13 and 14 are amended by this proposed amendment. No new matter has been added.

Claims 1 – 20 are finally rejected under 35 USC §112 as failing to comply with the written description requirement.

With regard to claims 1 and 9, the Final asserts that the specification “does not expressly, implicitly, or inherently support that visual cue objects or visual feedback are inserted into the file” and asserts that instead, the application teaches “inserting visual feedback into said original document” as the claims are amended to recite by this proposed amendment. Final Office Action (Final), #4, page 5. No new matter is added. Entry of the amendment, reconsideration and withdrawal of the final rejection of claims 1 and 9 under 35 USC §112 is respectfully requested.

With regard to claim 2, the Final asserts that the “original disclosure fails to describe **accessing** all features or the plug-ins **becoming active**.” Final, #5, page 5 (emphasis added). However, that is not quite what claim 2 recites.

Claim 2 recites that “document viewing application **provides access** to all features while the plug-ins **are active** in said document viewing application.” Lines 3 – 5 (emphasis added). This does not require accessing all features; it is merely a statement that all of the document viewing application features are available (or are not made unavailable), when the plug-ins are installed in document viewing application, i.e., are active. There would be no point in installing inactive plug-ins or plug-ins that remained inactive. The specification specifically supports this by describing how, with the plug-ins in the standard desktop publishing type software, “[t]he job originator then has all the advantages of the viewing application when ticketing the job, such as thumbnail drag-and-drop and other manipulations, ... [and] can use a familiar interface to view documents without having to learn a new application.” Abstract, and paragraphs 0005,

16 and 17. Reconsideration and withdrawal of the final rejection of claim 2 under 35 USC §112 is respectfully requested.

With regard to claims 5 and 13, the Office Action asserts that the specification “fails to describe inserting or removing visual cue objects from a file.” Final, #6, page 5. Responsive thereto, claims 5 and 13 are amended to recite inserting and removing visual cues from the original document, which is supported by the original specification. See, e.g., original claim 1. No new matter is added. Entry of the amendment, reconsideration and withdrawal of the final rejection of claims 5 and 13 under 35 USC §112 is respectfully requested.

With regard to claims 6 and 14, the Office Action asserts that the specification “fails to describe creating a print job ticket when markers are removed.” Office Action, #7, page 3.

Figure 3 shows the step “Selectively remove visual cue” being immediately followed by the step “Prepare print instructions.” See, also, paragraph 0031. Claims 6 and 14 are amended to recite that the “set of visual job ticketing plug-ins creating said print job ticket when said visual feedback is removed.” Lines 4 – 5. No new matter is added. Entry of the amendment, reconsideration and withdrawal of the final rejection of claims 6 and 14 under 35 USC §112 is respectfully requested.

Further, having amended claims 1, 5, 6, 9, 13 and 14 and having traversed the rejection of 2, all claims are believed to be supported by the specification. Entry of the amendment, reconsideration and withdrawal of the final rejection of claims 1 – 20 for failing the written description requirement under 35 USC §112 is respectfully requested.

Claims 1, 3 – 9 and 11 – 16 are finally rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,614,454 to Livingston in combination with U.S.

Patent No. 5,999,945 to Lahey et al. and U.S. Patent No. 6,407,820 to Hansen. Claims 2 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Livingston, Lahey et al. and Hansen in view of U.S. Patent No. 6,880,124 to Moore. Claims 17 – 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Livingston, Lahey et al. and Hansen in view of U.S. Patent No. 6,268,924 to Koppolu et al. The final rejection is amended, at least in part.

With regard to the editor recited in claim 16 and the word processor of claim 17, the Final relies on the Livingston display of Figures 3A and 3B and description at col. 1, line 56 – col. 2, line 10. Final #9, page 10 and #11, page 13.

As previously noted, however, Livingston teaches a “method of **displaying** multiple printer options **in a graphical user interface** [that] includes dividing a viewing window into first and second portions separated by a first divider including a first visible affordance and displaying a scrollable list of features in the first portion together with a scroll bar.” Livingston, col. 1, lines 40 – 44 (emphasis added). So, the Livingston GUI divides a window in three. “The graphical user interface is configured to allow user selection and modification of print engine options for printing the document.” *Id.*, col. 2, lines 19 – 21. Modifying “print engine options for printing” is different than editing with an editor, or especially, with a word processor. Therefore, the combination of Livingston, Lahey et al. and Hansen in view of Koppolu et al. fails to teach or suggest the present invention as recited in claims 16 and 17. Reconsideration and withdrawal of the final rejection of claims 16 and 17 under 35 USC §103(a) is respectfully requested.

Neither does modifying “print engine options for printing” teach or suggest the same Livingston interface having “capabilities for drag-and-drop, zooming, displaying multiple-pages, opening multiple documents simultaneously, adjusting document content, bookmarking and document navigation;” as claims 1 and 9 are amended by this proposed amendment. Neither is this taught or suggested by any other reference of record. This

amendment to claims 1 and 9 is supported in the specification by the Abstract and paragraph 0005. No new matter is added. Entry of the amendment, reconsideration and withdrawal of the final rejection of claims 1 – 15 and 18 – 20 under 35 USC §103(a) is respectfully requested.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicants respectfully request entry of the amendment, reconsideration and withdrawal of the rejection of claims 1 – 20 under 35 U.S.C. §§112 and 103(a) and allowance of the application to issue.

Should anything further be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 50-3669 and advise us accordingly.

Respectfully Submitted,

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